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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,054	11/21/2001	Dean R. Dodge	1316N-001660	1466

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EXAMINER

BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 07/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/990,054

Applicant(s)

DODGE ET AL.

Examiner

Melody M. Burch

Art Unit

3683

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-6

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

[Signature]
CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER

Continuation of 3. Applicant's reply has overcome the following rejection(s): 112 first rejection of claim 6, lack of antecedent basis, specification objection, new matter drawing objection.

Continuation of 5. does NOT place the application in condition for allowance because: With regards to the drawing objections Applicant states that in paragraph 24 of the specification, it is stated that the valve assembly 64 comprises a disc 90 and disc 92. Accordingly, Examiner has withdrawn the new matter objection. Applicant also states that the specification provides support for incorporating the valve assembly 64 on either side of the piston 32 which explains the presence of the four discs shown in figure 5. Examiner notes that figure 5 shows two different embodiments in one drawing. Examiner also notes that a proper illustration of the valve assembly being located on either side of the piston 32 would include one figure in which discs 90 and 92 are shown above the piston and another figure in which discs 90 and 92 are shown below the piston. Applicant further explains that original figure 5 identifies valve assembly 64 as being located on the lower side of piston. Examiner notes that original figure 5 showing four unlabeled discs does not provide any indication as to which side of the piston valve assembly 64 is located. With regards to the 112 first rejection, Examiner notes that the amendments overcome the rejection, but notes that the same problem exists at the end of claim 4. With regards to the rejections on the merits, Applicant states that the Examiner is relying on Tanaka to provide the chordal edge. Examiner notes that the Tanaka and the Yamaura et al. references together are used to provide the teaching of a disc having a chordal edge. Tanaka teaches in figure 3a and in col. 5 lines 46-51 that a single portion shown in the area of element 19a of the outer edge of disc 19 can be shaped in any various ways to satisfy desired damping force requirements. Yamaura et al. teach in figure 4 the use of a disc specifically having a chordal outer edge. Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the outer edge of the disc of Furuya et al. to have included a single portion having a chordal edge, in view of the teachings of Tanaka and Yamaura et al., in order to provide a means of achieving a desired damping force as best determined by routine experimentation. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971). Examiner maintains that it is evident from the prior art references that it was within the level of ordinary skill at the time of the claimed invention was made to modify a single portion of an outer edge of a disc to generate particular damping effects and to modify the outer edge of a valve disc to be in the form of a chord.

Applicant further argues that the recess of Tanaka would not be a recess if it is modified to take on the form of a chord. Examiner notes that although Tanaka is simply used for the teaching of making a single outer edge of a disc any appropriate shape, it is maintained that recess is also defined as a recession or an act of receding. Examiner notes that, in light of the definition, a chord is a linear recession from the circular outer edge of the disc. Applicant also argues that disc 144 of Yamaura et al. is not adjacent to disc 132. Although Examiner notes that the Yamaura et al. reference was simply used for the teaching of the outer edge specifically being chordal, Examiner maintains that the discs are adjacent via an intervening element and that during large deflections of element 138, the second valve disc has an outer edge that supports the first valve disc.

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7/15/03